(18)

Office - Supreme Court, U. S.
FILED
JUL 11 1941
CHARLES ELMORE CROPLEY
CLERK

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

314-674

Nos. 257, 258, 259

MINNESOTA MINING & MANUFACTURING COMPANY,

Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF PATENTS.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA AND BRIEF IN SUPPORT THEREOF.

PAUL CARPENTER,
HAROLD J. KINNEY,
Counsel for Petitioner.

INDEX.

Subject Index.

Page

Petition:
- Caption 1
- Short and summary statement of the matter involved 2
- Questions presented 6
- Reasons relied upon for the granting of the writs of certiorari 8
  1. The construction and practical working of a United States Statute, in respect to appellate review, is involved 8
  2. No court ever previously held in a suit to obtain a patent that reasonable doubts should not be resolved in favor of invention 8
  3. The United States Court of Appeals, D. C., is itself divided on the questions of law presented 10
  4. The decision of the majority (two judges) on the questions here presented is in conflict with the prior uniform rulings of the same and other courts 11
  5. This Court has never squarely passed affirmatively on the principle of resolving doubts in favor of invention, though certain of this Court's decisions have been judicially understood to support such principle 12
  6. Appellate courts generally have followed the principle in appellate review that they have the power and duty fully to review whether the trial court's findings on patentable *invention* are legally sound, based upon the record 13

Page

7. The Court of Appeals, D. C., has recently expressly recognized that questions 2 and 3 hereof are unsettled questions of law 13
8. The majority ruling of the Court of Appeals, D. C., is confusing two established and consistent principles of law 15
9. In doubtful cases, leave to file a petition for a bill of review should be granted as a matter of course 16
10. Appellate Courts should take full judicial notice of new matter and circumstances which supervene between judgment by the trial court and hearing on appeal 17
11. It is impossible to ever have any Federal appellate court except the Court of Appeals, D. C., pass on the questions of law here presented, involving appellate review in a suit to obtain a patent (Sec. 4915 R. S.) 18

Brief:

The opinion of the court below 19
Jurisdiction 20
Statement of the case 20
Specification of errors 20
Summary of argument 20
Argument 20
Conclusions 24

Appendix:

Statutes cited 26

TABLE OF CASES CITED.

In re Amand, 63 F. (2d) 117, 119 12
Battery Patents Corp. v. *Coe*, 93 F. (2d) 220, 226 ..... 11, 18
Berry v. *Robertson*, 40 F. (2d) 915, 921 ..... 11, 15
Butterworth, Comm. of Patents v. *Hill et al.*, 114 U. S. 128 20
Cleveland Trust Co. v. *Schriber-Schroth Co.*, 92 F. (2d) 330, 334 24
Cooper v. *Robertson*, 46 F. (2d) 766, 769 ..... 11, 13

Page

In re Coykendall, 29 F. (2d) 868, 870 11
Dyer v. *Coe*, Appeal No. 7374 14
Egry Register Co. v. *Standard Register Co.*, 1 F. (2d) 11, 12 16
Forward Oil Co. v. *Coe*, 116 F. (2d) 946 10
Gandy v. *Marble, Comm. of Patents*, 112 U. S. 432 .. 20
General Motors Corp. v. *Coe*, 50 U. S. P. Q. 10 10
Gyro Process Co. v. *Coe*, 107 F. (2d) 195, 200 11
In re Kirby, 109 F. (2d) 786, 788 11
Kurtz v. *Belle Hat Lining Co., Inc.*, 280 F. 277 13
McClain v. *Ortmayer*, 141 U. S. 419, 427 ..... 23, 24
Minnesota v. *National Tea Co.*, 309 U. S. 551, 555 17
Minnesota Mining & Manfg. Co. v. *Coe*, 118 F. (2d) 593 19
Minnesota Mining & Manufacturing Co. v. *Coe*, Appeal No. 7533 14
Morgan v. *Daniels*, 153 U. S. 120 11
National Brake & Electric Co. v. *Christensen*, 254 U. S. 425, 431 17
Patterson v. *Alabama*, 294 U. S. 600, 607 17
Pittsburgh Forgings Co. et al. v. *American Foundry Equipment Co.*, 49 U. S. P. Q. 153, 154 16
Poulson v. *Coe*, 119 F. (2d) 188, 199 18
Powers v. *Comm. of Internal Revenue*, 312 U. S. 259 ..... 16, 23
In re Pupin, 299 F. 697, 701 12
Raffold Process Corp. v. *Castanea Paper Co.*, 105 F. (2d) 126, 129 16
Sharp v. *Coe*, Appeal No. 7400 14
State Tax Comm. v. *Van Cott*, 306 U. S. 511, 515 .. 17
In re Stevenson, 10 F. (2d) 1008, 1009 12
Textile Machine Works v. *Louis Hirsch Textile Machines, Inc.*, 302 U. S. 490 13
Vandenbark v. *Owen-Illinois Glass Co.*, 311 U. S. 538 17
In re Zenk, 267 F. 327, 330 11

TABLE OF STATUTES CITED.

Judicial Code, Section 240 (a); 28 U. S. C. 347 8
Revised Statutes, Section 4886; 35 U. S. C. 31 26
Revised Statutes, Section 4915; 35 U. S. C. 63, 3, 7, 8, 9, 10, 11, 13, 22

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

Nos. 257, 258, 259

MINNESOTA MINING & MANUFACTURING COMPANY,

Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF PATENTS,

Respondent.

PETITION FOR WRITS OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Minnesota Mining & Manufacturing Company, by its undersigned attorneys, respectfully prays that three Writs of Certiorari issue to the United States Court of Appeals for the District of Columbia to review the judgments of that court entered on December 30, 1940, in three appeals (Nos. 7539, 7540 and 7541) all entitled as above, affirming the Judgments of the District Court in which petitioner's Complaints were dismissed as to all *except two* of the claims for letters patent in issue (R. 90,

215 and 282). (Said causes were consolidated for purposes of trial, and for argument on appeal.) A petition for rehearing (R. 312-321) was filed and was denied February 12, 1941, *one of the Justices repeating his dissent on the merits,* however (R. 334).

A transcript of the record, including the proceedings in the said United States Court of Appeals for the District of Columbia, is furnished herewith in accordance with Rule 38 of this Court. The time for filing this petition has been extended by this Court (R. 341).

Short and Summary Statement of the Matter Involved.

This Court need not necessarily be concerned about the facts, because the parties are not in disagreement as to the essential facts, which are set out satisfactorily, though in rather brief form, in the Opinion of the United States Court of Appeals for the District of Columbia (R. 308). However, the main facts are here set out, as follows:

Three patent applications are here involved, two applications of Byron J. Oakes and one application of Howard G. Bartling. Each is directed to an abrasive article, especially a flexible abrasive article of the coated abrasive type, commonly referred to as "sandpaper", though adapted to be used in various forms such as abrasive belts, etc. The gist of the inventions is a new flexible abrasive article of the coated abrasive type, which is bonded with vinyl polymers or resins. It is admitted by the appellee-respondent that this is new in the art and definitely useful. Advantages of the construction over prior art constructions are set forth reasonably adequately in the appellate court's opinion (R. 308).

One Oakes application was filed in the United States Patent Office on August 24, 1931 as Serial No. 558,872. The other Oakes application was based directly on the former

and was filed in the U. S. Patent Office on September 2, 1938, as Serial No. 228,188, in order to present other and differently worded claims.

The Bartling application was filed in the U. S. Patent Office on October 6, 1933 as Serial No. 692,436, the same being based directly on the earlier Bartling application, Serial No. 372,549, filed June 20, 1929.

For convenient reference, the relation of these patent applications to the equity numbers in the trial court, and the appeal numbers in the Court below, is as follows:

(1) Oakes Serial No. 228,188—Civil Action No. 851—Appeal No. 7539;

(2) Oakes Serial No. 558,872—Equity No. 63,916—Appeal No. 7540; and

(3) Bartling Serial No. 692,436—Equity No. 63,261—Appeal No. 7541.

All the claims of each of said applications were rejected as unpatentable by the Patent Office (R. 63, 210 and 276) and petitioner, as assignee of Oakes and also of Bartling, brought suits against the Commissioner of Patents under Revised Statutes, Sec. 4915, as amended by the Acts of March 2, 1927 and March 2, 1929, 35 U. S. C. 63 (Appendix, p. 26) in the District Court of the United States for the District of Columbia, praying that the Commissioner of Patents be authorized and directed to issue to it Letters Patents including the rejected claims of the aforesaid Oakes and Bartling applications (R. 3, 138 and 250). That Court, in judgments dated June 21, 1939 (R. 90 and 215) and June 26, 1939 (R. 282) dismissed petitioner's complaints as to all *except two* of the claims in issue (R. 90), holding that the claims were unpatentable over a combination of prior art patents. The two claims held patentable by the District Court, i. e. claims 4 and 5 of Oakes S. N. 228,188 (R. 3),

bear a considerable analogy to other claims held unpatentable, and the legal basis on which said claims were held patentable is also generally applicable to claims held unpatentable; note Record, page 84, where the trial court, in discussing the Oakes invention, said: "His invention solved the problem of the glass industry. It is new to the art and decidedly useful and, therefore, patentable. Claims 4 and 5 are allowed."

The gist of the rejection by the trial court is a holding that patents such as Ostromislensky (R. 179), Klatte, et al. (R. 158), Collins (R. 197), etc., showing vinyl resins *per se* but making no reference to their use in sandpaper, could be validly combined with patents such as Carlton (R. 189), Klein, et al. (R. 177), etc., showing sandpaper but making no reference to the use of vinyl resins therein. Petitioner pointed out to the District Court that this holding was without precedent and was, furthermore, repugnant to the validity of the claims of Robie patent No. 2,111,006 (R. 95), which issued on an application based upon an original filing date of October 4, 1934, which is long subsequent to the original filing dates of both Oakes and Bartling; also that such holding was repugnant to the validity of the claims of Hepp patent No. 1,932,104 (R. 67), which issued on an original application filed January 15, 1932 i. e. subsequent to both Oakes and Bartling. Both Robie and Hepp claim abrasive articles, including sandpaper, in which particular vinyl resins and classes of vinyl resins are employed as a bond or binder adhesive. The United States Court of Appeals, D. C., by a majority of the three justices who heard the case, rendered a decision dated December 30, 1940 (R. 307), affirming the said judgments of the lower court, *Justice Stephens dissenting on the merits* (R. 310 and 333).

Thus the claims in issue define subject matter (abrasive articles) which is new over all the prior art and is decidedly

useful, and furthermore possesses a number of special advantages because of such novel construction (R. 307 and 308); in compliance with Revised Statutes, section 4886 as amended by the Act of May 23, 1930 (Appendix p. 26). Furthermore generally similar claims, directed to vinyl resin bonded abrasives including sandpaper and of indistinguishable scope (R. 310 and R. 98, 303-B and 68) have been allowed to other applicants on later applications: the claims in issue are *a fortiori* patentable on the same basis on which the Robie, Paulson and Hepp patents (R. 95, 303-A and 67) were granted. Interferences are now pending in the Patent Office between two Oakes applications, each based upon Serial No. 558,872 aforesaid, and claims 1 to 10 of said Robie patent (R. 98) and claims 1 and 2 of said Paulson patent (R. 303-B), respectively. That part of the decision of the trial court which has been affirmed by the Court of Appeals (R. 307), by a divided court, is repugnant to the validity of the claims which form the counts of said presently pending *Oakes* v. *Paulson* (R. 298-99 and 303) and *Oakes* v. *Robie Interference* (R. 98 and 322 (end)). Both of said Interferences are now awaiting decision by the Patent Office on the question of priority, no decision having thus far been rendered, though arguments at final hearing were heard on April 16 and 17, 1941. Both Interferences, their substance and status and their relation to the claims here in issue, were fully discussed in petitioner's brief to the Court of Appeals, and the fact that certain counts thereof (taken from the Robie and Paulson patents) dominated and are of a scope indistinguishable from claims here in issue was particularly stressed. These facts are generally recognized by the Court of Appeals in its opinion (R. 310).

The *Oakes* v. *Paulson Interference* was declared by the Patent Office on April 12, 1940 (R. 302), i. e. after judgment

by the trial court and appeal to the Court of Appeals. This fact was called to the attention of the Court of Appeals on May 3, 1940 (long before hearing) in a Petition for Leave to Apply to the District Court for Rehearing (R. 296). Count 1 of said Interference is similar and even broader in scope than many of the claims here in issue (R. 299-300). The *Oakes* v. *Robie Interference* was pending at the time of trial before the District Court, and is still pending.

Questions Presented.

The grant of the relief prayed for by petitioner is dependent solely upon answering in the affirmative the following closely related questions of law:

1. Where, in a suit to obtain a patent under section 4915 R. S., the Court of Appeals definitely recognizes that the subject matter claimed in a patent application is clearly new and decidedly useful, and possesses a number of important practical advantages because of such novel construction, and the District Court did not make findings of fact to the contrary, and further where the Court of Appeals recognizes that reasonable doubts exist on the question of whether such subject matter involves patentable invention over the prior art, and the District Court made no definite adverse finding of fact on invention, should not the Court of Appeals under such circumstances resolve *reasonable doubts* in favor of patentable invention, the existence of said doubts being recognized by the majority of the Court of Appeals and emphatically confirmed by the dissent on the merits by one of the Justices thereof?

2. More specifically, under such circumstances, and further when claims of similar and indistinguishable scope have been held patentable by the Patent Office and issued in one or more patents on the later filed application or

applications of one or more others, should not the Court of Appeals hold that this sufficiently indicates the inventive character of such subject matter as to merit issuance of letters patent thereon so as to avoid casting a cloud on the validity of said claims of said patent or patents in a proceeding in which neither the patentee nor his assignee is a party?

3. Where it is definitely recognized by the Court of Appeals that subject matter of claims in a patent application is novel and useful, and that, as shown by unquestioned and uncontradicted evidence, it possesses a number of special advantages because of such novel construction, and further where a decision is rendered by the Patent Office subsequent to judgment by the District Court again holding patentable claims of a patent and setting up an Interference (which is still pending and undecided) between the patent containing said claims and another application which is based on the aforesaid application, the claims forming the counts of said Interference being of scope similar to and indistinguishable from the aforesaid claims of said application, here in issue, should not the Court of Appeals in a suit under section 4915 R.S., to obtain a patent, take full judicial notice of such supervening circumstances and resolve reasonable doubts in favor of "patentable invention" so as to avoid a decision in conflict with the present view of the Patent Office on the patentability of the claims forming the counts of said Interference; or, in the alternative, should not the Court of Appeals recognize that such circumstances raise a real doubt against the validity of the District Court's judgment, and, therefore, accordingly grant Petitioner's (Appellant's) petition for leave to apply to the District Court for leave to file a bill of review?

Reasons Relied Upon for the Granting of the Writs of Certiorari.

The discretionary power of this Court is invoked (under section 240 (a) of the Judicial Code, 28 U. S. C. 347, as amended by the Act of February 13, 1925) upon the following grounds:

1. The construction and practical working of an important United States Statute in respect to Appellate review of the trial court's decisions, depends upon answering in the affirmative the questions of law raised.

The United States Court of Appeals for the District of Columbia has announced a novel principle of appellate practice involving the construction and practical working of a statute of the United States (Revised Statutes, section 4915, 35 U. S. C. 63, as amended by the acts of March 2, 1927 and of March 2, 1929, respectively—Appendix p. 26). Namely, that court has answered in the negative each of the three questions set out above. If such principle of practice were allowed to continue, the scope of appellate review in suits of this nature would be narrowed to the point of virtual impotency; in effect, the right of appellate review under section 4915 R. S. would be abrogated and the trial court would be allowed a very wide discretion in deciding that new and useful improvements in the arts do or do not involve "invention", even though its findings thereon were inconsistent with established rules of law, unless its findings were so manifestly erroneous and arbitrary as virtually to "require" reversal by the Court of Appeals (R. 310).

2. No court, prior to the Court of Appeals, D. C., in this case, ever held in a suit under Section 4915 R. S. to obtain a patent (or in any proceeding) that reason-

able doubts on the question of "invention", as to novel and decidedly useful subject matter, were not to be resolved in favor of him who seeks a patent.

The essentials of patentability are often said to be: (1) novelty; (2) utility; and (3) invention. It is possible unquestionably to establish "novelty" and "utility" by evidence. Because of the nature of the question of "invention", however, it is not possible unquestionably to establish the existence of "invention"; see authorities (R. 314 and 315). The question of invention is "a question of fact, to be determined, however, by rules of law" (R. 314) and, as such, it is somewhat analogous to, though much more difficult than, such questions as "due care" or "due diligence" under a given statute. By way of comparison, if a jury in a criminal trial had found an accused to be guilty of second degree murder and the trial judge had passed sentence accordingly, who should question the proposition that the reviewing court may determine on appeal whether the doctrine was correctly applied that reasonable doubts are to be resolved in favor of innocence of the accused and, if not correctly applied, reverse the lower court. If real doubts on the question of "invention" are not to be resolved by the Court of Appeals in a case of this character in favor of one who seeks a patent, after novelty, utility and a number of special advantages have been definitely proven, it is difficult if not impossible to conceive of a situation where an appellant could prevail in a case of this character, even though the ruling of the District Court on the question of "patentable invention" was very unharmonious with established rules of law and settled indicia of invention. In other words, if such a rule is established, the Court of Appeals, D. C., will in effect have resigned and renounced its powers and duties of appellate review under section 4915 R. S., insofar as rulings

on the question of "patentable invention" by the trial court is concerned, except where the trial court's finding on that question is so manifestly erroneous as to virtually "require" reversal by the Court of Appeals.

3. The United States Court of Appeals for the District of Columbia is itself divided on the proper answer to the legal questions herein presented, Justice Stephens dissenting on the merits from the other two Justices.

This fact may be noted by referring to the record (R. 310 and 333). Never prior to the institution of the present appeals before the Court of Appeals, D. C. was a decision rendered adverse to the appellant in a suit of this kind, to obtain a patent, when one of the Justices considered the appellant entitled to a patent on the merits. In other words, there is no reported decision prior to the institution of the present appeals in which a decision adverse to the appellant was rendered on the question of "invention" by a divided court. (However, subsequent to the institution of these appeals, in *Forward Oil Co.* v. *Coe,* 116 F. (2d) 946 (decided December 9, 1940), the Court of Appeals, with one justice dissenting, rendered a decision adverse to appellant on the merits, but there the question of "resolving reasonable doubts" was not discussed and apparently was not involved.)

Since the Court of Appeals decision in the instant causes, that Court has rendered another decision in a suit under section 4915 R. S., in which they cite their decision in the present cases as authority, on the novel point that doubts are not to be resolved in favor of "invention"; see *General Motors Corporation* v. *Coe,* 50 U. S. P. Q. 10; (decided June 16, 1941), as to which a Petition for Rehearing is now pending.

4. The decision of the majority of the Court of Appeals (two justices) on the question of resolving doubts in favor of patentable invention is in conflict with the uniform rulings by the same Court in earlier decisions, and also is in conflict with uniform rulings in other jurisdictions.

The Court of Appeals, D. C., repeatedly held, in the case of appeals directly from the Patent Office to that court, that doubts are to be resolved in favor of the inventor; see, for example, *In re Zenk,* 267 Fed. 327, 330; 50 App. D. C. 25 (1920); and *In re Coykendall,* 29 F. (2d) 868, 870; 58 App. D. C. 280 (1928). Since the determinations or findings of fact of the Patent Office, as well as those of a Federal District Court, are entitled to a presumption of correctness (*Morgan* v. *Daniels,* 153 U. S. 120, 14 S. Ct. 772, 38 L. Ed. 657), no logical reason exists why a rule should be applied in respect to appeals from the District Court under section 4915 R. S. different from that in direct appeals from the Patent Office. Additionally the Court of Appeals, D. C. has previously followed this rule in appeals from the District Court under section 4915 R. S.; see *Battery Patents Corp.* v. *Coe,* 93 F. (2d) 220, at end of 226 and top of 227 (1937). This rule is also inherent in the decision of the Court of Appeals, D. C., in *Gyro Process Co.* v. *Coe,* 107 F. (2d) 195, at 200 (1939).

The Court of Customs and Patent Appeals has also repeatedly held that reasonable doubts will be resolved in favor of "invention" or patentability; see *In re Kirby,* 109 F. (2d) 786, at 788 (1940).

A similar rule has been recognized in the Fourth Circuit when suits under section 4915 R. S. were tried there: see *Berry* v. *Robertson, Comm. of Patents,* 40 F. (2d) 915, at 921 (1930); and *Cooper* v. *Robertson,* 46 F. (2d) 766, at 769 (1931).

5. This Court has never squarely passed upon the question of resolving doubts in favor of "invention" or "patentability", though some of this Court's decisions have been judicially characterized as "in point" on the familiar rule that, where doubt exists as to "invention", it should be resolved in favor of the inventor.

The United States Court of Customs and Patent Appeals in *In re Amand*, 63 F. (2d) 117, at 119 (1933) stated:

> "Upon the whole record, we are of opinion that this presents one of those cases in which there is a doubt which should be resolved in appellant's favor. The rule is a familiar one and requires no elaborate citation of authorities, of which appellant has listed a large number. The familiar case of Eibel Process Co. *v.* Minnesota & Ontario Paper Co., 261 U. S. 45, 43 S. Ct. 322, 67 L. Ed. 523, seems in point, as does the case of Richmond Screw Anchor Co. *v.* United States, 275 U. S. 331, 48 S. Ct. 194, 72 L. Ed. 303. Another is that of In re Kirschbraun, 44 F. (2d) 675, 18 C. C. P. A. 735."

Upwards of fifty other decisions could be cited which repeat the familiar rule that reasonable doubts on the question of invention are to be resolved in favor of him who seeks a patent; see *In re Stevenson*, 10 F. (2d) 1008, at 1009, 56 App. D. C. 143 (1926); and *In re Pupin*, 299 Fed. 697, at 701, 55 App. D. C. 14 (1924). No authority can be found in opposition to this rule. Moreover appellee-respondent admitted that this is the general rule on page 4 of his memorandum dated January 22, 1941, in opposition to Appellant's Petition for Rehearing, where he stated:

> "The resolving of doubt in favor of an applicant for patent is the rule followed by the Primary Examiner and Board of Appeals of the Patent Office, and probably also by the District Court according to Berry *v.* Robertson, 40 F. (2d) 915, cited by Appellant. * * * It is not seen that this 'tender consideration' accorded

to applicants should be continued further in a Court of Appeals * * *."

It is noteworthy that the words "tender consideration" are from the decision of the Circuit Court of Appeals, 4th Circuit, in *Cooper* v. *Robertson*, 46 F. (2d) 766, at 769 (1931) where in a suit under section 4915 R. S. to obtain a patent that court referred to—

> "that *tender consideration* which should be given *always* to inventive genius" (emphasis added).

Thus the views of the appellee-respondent are opposed to those of the Fourth Circuit, in this latter respect.

6. In suits generally which involve the question of patentable invention of claims, appellate courts have commonly followed the principle that they have the right fully to investigate whether the trial court's determination on the question of patentable invention is or is not consistent with rules of law.

Illustrative of the great mass of cases illustrating this point is *Textile Machine Works* v. *Louis Hirsch Textile Machines, Inc.*, 302 U. S. 490, 58 S. Ct. 291, 82 L. Ed. 382 (1938) and *Kurtz* v. *Belle Hat Lining Co., Inc.*, 280 Fed. 277 (C. C. A. 2d, 1922). It would be a startling new principle of appellate practice in infringement suits, as well as in suits under section 4915 R. S., if appellate courts were not permitted independently to investigate and determine whether they, in their judgment, believed the trial court correctly applied rules of law in determining whether the claims in issue involve patentable invention, and to pass judgment in accordance with such determination.

7. The ruling of the Court of Appeals in the instant cases to the effect that the inconsistent granting of patents on applications of others does not show that the Patent Office should have held the claims in issue to be

> patentable, even where novelty, utility and a number of advantages of the subject matter of the claims in issue have been judicially recognized by the Court of Appeals, has recently been recognized by said Court of Appeals (including different judges) to be an open question of law.

The Court of Appeals in its majority opinion in the instant causes (R. 310), in referring to the issuance by the Patent Office of the Robie, Paulson and Hepp patents (R. 95, 303-A and 67) stated:

> "The inconsistent granting of other applications no more proves the Office wrong in rejecting the present claims than inconsistent rejection of other applications would prove it wrong in granting claims."

This is a surprising statement. Also it is in conflict with the well established principle that issued patents are presumed to be valid.

Furthermore the Court of Appeals, D. C. in *Minnesota Mining and Manufacturing Company* v. *Coe,* Appeal No. 7533 (which is an appeal entirely separate from the present causes) entered Order dated July 2, 1941, reading as follows:

> "It is Ordered by the Court that the above entitled appeal be, and it is hereby, set down for rehearing with No. 7400, *Sharp* v. *Coe,* and No. 7374, *Dyer* v. *Coe,* during the October Term, 1941, on the question whether allowed claims can be used as a measure of the patentability of rejected claims."

The issuance of this Order by the Court of Appeals indicates that the refusal of the majority of the Court in the instant causes to recognize the claims of the Robie, Paulson and Hepp patents as a measure of the patentability of the claims in issue, was based upon a novel and *unsettled* state-

ment of law, which furthermore is opposed to the familiar rule that doubts are to be resolved in favor of an applicant for a patent.

8. The majority ruling of the Court of Appeals, D. C., is confusing two established and consistent principles of law.

It is established by very many decisions (and there are no authorities to the contrary) that reasonable doubts should be resolved in favor of patentable invention, as above pointed out. It is also clearly established by many decisions that, in Federal appellate procedure Courts of Appeals will not disturb the trial court's findings as to *facts* unless convinced of their error. These principles are not in conflict. The initial presumption by the Court of Appeals that the trial court was correct in holding against patentable invention is, of course, sound; but this *initial* presumption was overcome when the Court of Appeals concluded that "reasonable doubt" existed (R. 309) and that the record was "persuasive that a reasonable mind might find invention here" (R. 310); also when the Court of Appeals specifically found novelty, utility and a number of special advantages to exist whereas the trial court failed to make such findings even after a motion for additional findings was presented.

For all that is shown on the record, the trial court may have failed, and evidently did fail to apply the doctrine of resolving reasonable doubts in favor of invention, which appellee-respondent admits is "probably" applicable to "the District Court according to *Berry* v. *Robertson,* 40 F. (2d) 915"; see *supra.* Erroneous applications or the non-application of rules of law by a trial court should be reviewed and corrected on appeal. The trial court could not have been free of doubt on the question of invention in the instant causes; to conclude that it was free of doubt would

be repugnant to the validity of the claims of the Robie patent; also the Paulson and Hepp patents.

Thus there is no conflict between the two principles aforesaid and, contrary to the ruling of the majority of the Court of Appeals, a finding of no invention by the trial court (which was only made by implication) in no way prevents or excuses the Court of Appeals from fully determining whether the trial court correctly applied the settled doctrine that reasonable doubts are to be resolved by the trial court in favor of "patentability" or "invention". Criteria or standards of "invention", like criteria or standards of "valuation", are subject to full review on appeal; see *Powers* v. *Commissioner of Internal Revenue*, 312 U. S. 259, 61 S. Ct. 509, 85 L. Ed. 435 (1941).

9. Where new matter arises subsequent to judgment by the trial court which raises a doubt as to the correctness of the trial court's judgment, leave to petition the trial court for a bill of review should be granted by federal appellate courts as a matter of course.

This point applies particularly to question 3.

The declaration by the Patent Office of the Oakes v. Paulson Interference on April 12, 1940 (R. 302) constitutes pertinent new matter. The denial by the Court of Appeals (R. 334) of appellant's Petition for leave to apply to the District Court for a bill of review is opposed to the rule that "whenever the right to file a bill is at all doubtful, leave is granted as a matter of course": *Egry Register Co.* v. *Standard Register Co.*, 1 F. (2d) 11, at 12 (C. C. A., 6th, 1924). The same rule is stated and followed in *Raffold Process Corp* v. *Castanea Paper Co.*, 105 F. (2d) 126, at 129 (C. C. A., 3rd Cir. 1939) and in *Pittsburgh Forgings Co. et al.* v. *The American Foundry Equipment Co.* (decided March 31, 1941—C. C. A., 3rd Cir.) 49 U. S. P. Q.

153, 154. Also that "leave to file a supplemental petition in the nature of a bill of review may be granted after the judgment of the appellate court" is shown by this Court's decision in *National Brake and Electric Co.* v. *Christensen,* 254 U. S. 425, 431, 41 S. Ct. 154, 65 L. Ed. 341, at 343. This Court also has held that "Intervening and conflicting decisions will thus cause the reversal of judgments" even where such judgments "were correct when entered": *Vandenbark* v. *Owen-Illinois Glass Co.,* 311 U. S. 538, 61 S. Ct. 347, 85 L. Ed. 317, at 320 (1941). It is incongruous with such decisions for the Court of Appeals to ignore the declaration and pendency of the Oakes v. Paulson Interference, count 1 of which is of scope similar to and indistinguishable from claims here in issue.

10. Pertinent new circumstances or new matter, arising subsequent to judgment by the trial court, is entitled to full judicial notice by the Court of Appeals.

This Court stated in *Patterson* v. *Alabama,* 294 U. S. 600, 607; 55 S. Ct. 575; 79 L. Ed. 1082, 1086 (1935) that—"in determining what justice does require, the court is *bound* to consider any change, either in fact or in law, which has supervened since the judgment was entered". This rule has also been equally applied in civil, as well as in criminal cases: *State Tax Comm.* v. *Van Cott,* 306 U. S. 511, at 515; 59 S. Ct. 605; 83 L. Ed. 950, at 953 (1939) and *Minnesota* v. *National Tea Co.,* 309 U. S. 551, 555; 84 L. Ed. 920, at 923; 60 Sup. Ct. 676, 679.

The Court of Appeals in the instant causes has acted contrary to this rule in ignoring, and rendering a decision inconsistent with the validity of the counts of the presently pending Oakes v. Paulson Interference, declared April 12, 1940, i. e. after judgment by the trial court.

11. Since the Commissioner of Patents now uniformly refuses, and for some time past has uniformly refused to accept service outside the District of Columbia in suits under section 4915 R. S., it is impossible in the future to secure rulings of other Federal Circuits on the questions of law here presented, as applied to appellate review under said section 4915 R. S.

The fact that there has been a dissent on the merits, where important points of law involving the constructive practical working of a statute are involved, should therefore be regarded as tantamount to a conflict of ruling between different Circuits in other cases. Under the latter circumstance Certiorari is frequently granted, and it is highly desirable that it likewise be granted here to avoid conflicting decisions between different judges of the Court of Appeals, D. C. Though the dissenting judge has written no dissenting opinion in the instant causes, his views are stated in cases where he has written the majority opinion; see *Battery Patents Corp.* v. *Coe,* 93 F. (2d) 220, at 226 (1937); and *Poulsen* v. *Coe,* 119 F. (2d) 188 at middle of column 2 on page 199 (1941).

WHEREFORE, your petitioner respectfully prays that three Writs of Certiorari be issued out of and under the seal of this Court directed to the United States Court of Appeals for the District of Columbia, commanding the said court to certify and send to this Court on a day to be designated a full and complete transcript of the record and all proceedings in the Court of Appeals had in these causes, to the end that the same may be reviewed and determined by this Court; that the judgments of the said Court of Appeals be reversed and that petitioner be granted such other and further relief as may be deemed proper.

MINNESOTA MINING & MANUFACTURING COMPANY, *Petitioner,*

By PAUL CARPENTER,
HAROLD J. KINNEY,

July 9, 1941. *Attorneys for Petitioner.*